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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR         | ATTORNEY DOCKET NO.     | CONFIRMATION NO. |
|---|-------------|------------------------------|-------------------------|------------------|
| 09/497,071  | 02/02/2000  | Linda I, Hoffberg-Borghesani | LIH-14                  | 7065             |
| 7590  | 04/23/2004  |                              | EXAMINER                |                  |
| Steven M Hoffberg<br>Milde Hoffberg & Macklin L&P<br>10 Bank Street Suite 460<br>White Plains, NY 10606 |             |                              | MA, JOHNNY              |                  |
|   |             |                              | ART UNIT                | PAPER NUMBER     |
|   |             |                              | 2614                    |                  |
|   |             |                              | DATE MAILED: 04/23/2004 |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

### **DETAILED ACTION**

Note, after careful consideration, the examiner has determined the effective filing date in regard to claims 155-160 to be 02/02/2000 (Filing date of the present application).

Please note:

As to claim 155, the claimed “storing in a memory means data representing said channel guide list” is rejected under 35 U.S.C. 112 as noted below. The claimed “and storing data representing characteristics of television programs previously watched by user” is supported by page 139; line 23 and page 140; lines 1-12 of Application No. 08/469,589. The claimed “performing a search of said channel guide list for a match to specific data representing said characteristics of television programs previously watched by viewer” is met by page 170; lines 16-25 of the instant application. The claimed “notifying said user of available television programs having characteristics similar to characteristics of a previously wanted television program” is supported by page 139; lines 13-15 of Application No. 08/469,589.

As to claim 156, please note the 35 U.S.C. 112 rejection discussed below.

As to claim 157, the claimed “wherein said step of notifying said user includes the step of producing a display including a list of the available television programs matched during said step of performing a search on a display screen for viewing by the user” is supported by page 140; lines 13-17 of Application No. 08/469,589.

As to claim 158, the claimed “further comprising a step of altering the produced display by a user using a data entry device” is supported by page 140; lines 13-17 of Application No. 08/469,589.

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|                              |                        |                            |  |
|------------------------------|------------------------|----------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b>        |  |
|                              | 09/497,071             | HOFFBERG-BORGHESANI ET AL. |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>            |  |
|                              | Johnny Ma              | 2614                       |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 02 February 2000.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 155-160 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 155-160 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____ .  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3.4</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____ .                                  |

As to claim 159, the claimed “further comprising the step of selecting one of the available television programs displayed on the list of available television programs” is supported page 141; lines 4-8 of Application No. 08/469,589.

As to claim 160, please note the 35 U.S.C. 112 rejection discussed below.

***Priority***

1. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph unless it appears in an application data sheet. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression “now Patent No. \_\_\_\_\_” should follow the filing date of the parent application. If a parent application has become abandoned, the expression “now abandoned” should follow the filing date of the parent application.

If the application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application. If the application is a utility or plant application which entered the national stage from an international application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be

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submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 155-160 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the examiner is unable to find support for the claimed, "storing in a memory means data representing said channel guide list".

As to claim 155, the Examiner acknowledges the specification supports the access of electronic program guide data. However, the examiner was unable to identify support for the source of such data being a memory in set top device.

As to claim 156, the examiner acknowledges the instant application discloses extracting the characteristics of the program from an electronic program guide (page 170, lines 16-29). However, the examiner was unable to identify support "performing a search of said television program-descriptive text.." The examiner further acknowledges support for stars where the specification discloses characterizing a selected program including actors and actresses present (page 175, lines 22-27). However, the examiner was unable to identify support for the use of title information.

As to claim 160, the examiner acknowledges the instant application supports the correlation of characteristics of past-selected programs (page 170, lines 16-29). However, the embodiment only specifically teaches a theme and the examiner was unable to identify support for the use of topic, title, and date characteristics.

*Specification*

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(f) he did not himself invent the subject matter sought to be patented.

6. Claims 155-160 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

Claims 155, 157-160 are met by Wehmeyer et al. (US Patent No. 5,867,226) as evidenced by the claim of the instant application being identical to claims 1 and 3-6, respectively, of the Wehmeyer et al. patent.

Claim 156 is met by Wehmeyer et al. (US Patent No. 5,867,226) as evidenced by the claim of the instant application encompassed by claim 2 of the Wehmeyer et al. patent.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Hendricks et al. reference (US 5,798,785) discloses a terminal for suggesting programs offered on a television program delivery system. "All of the methodologies for suggesting programs have in common the provision of gathering data that is representative of subscriber preferences. The microprocessor 602 will interpret, format and store this data in memory at the set top terminal 220." (column 29; lines 7-11). "Using program scheduling and descriptive information received from the operations center 202 or network controller 214 in either the program control signal or STTCIS, and the subscriber specific data, the set top terminal 220 can select programs suited to subscriber viewing preferences...These programs can

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be displayed on the television screen for viewer selection. Once the subscriber has indicated a selection by using, for example, a remote control 900 utilizing cursor movement, the microprocessor 602 at the set top terminal 220 can match the subscriber selection to the program and direct the set top terminal 220 to tune to the selected program" (column 29; lines 12-25). The Hendricks et al. reference also discloses "[t]o accomplish the analysis, clues as to the subscribers behavioral pattern must be saved in the set top terminals memory. These clues, such as programs watched and time periods of television viewing, are analyzed as necessary to develop a profile of the viewer." (column 29; lines 31-37). The Hendricks et al. reference further discloses a responsive embodiment using program abstracts (column 30; lines 4-13).

The Strubbe reference (US 5,223,924) discloses a system and method for automatically correlating user preferences with a T.V. program information database wherein "...a first memory portion can store, in the form of a database, information related to future television programs as well as information concerning those programs which are preferred by the user" (column 2; lines 38-42). The Strubbe reference further discloses a "...third database, could be accessed by the viewer via remote control 42, in order to allow him to select for viewing, only preferred programs which correspond either to forthcoming programs stored in the second database and indicated as 'liked', or programs automatically selected from the first database in the interest matcher mode..." (column 5; lines 36-42).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnny Ma whose telephone number is (703) 305-8099. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (703) 305-4795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jm



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